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12 **IN THE UNITED STATES DISTRICT COURT**
13 **FOR THE CENTRAL DISTRICT OF CALIFORNIA**

14 SALT OPTICS, INC., a California
15 Corporation,

16 Plaintiff,

17 vs.

18 JAND, INC. d/b/a WARBY PARKER,
19 a Delaware Corporation; THE BEAR
20 CAVE DESIGN, INC., a New York
21 Corporation, and DOES 1 through 10,
22 inclusive.

23 Defendants.

Case No.: SACV10-828DOC (RNBx)

**PLAINTIFF, SALT OPTICS, INC.’S
OPPOSITION TO DEFENDANTS’
MOTION TO DISMISS
PLAINTIFF’S SECOND AMENDED
COMPLAINT FOR FAILURE TO
STATE A CLAIM; MEMORANDUM
OF POINTS AND AUTHORITIES IN
SUPPORT THEREOF**

24 TO ALL PARTIES AND THEIR ATTORNEY’S OF RECORD:

25 PLAINTIFF, SALT OPTICS, INC. (“Plaintiff” or “SALT”) hereby submits
26 the following Memorandum of Points and Authorities in Opposition to
27 Defendants, Jand, Inc. dba Warby Parker (“JAND”) and The Bear Cave Design,

1 Inc.'s ("TBC's") motion to dismiss for failure to state a claim.

2 Defendants' motion to dismiss for failure to state a claim should be denied
3 on multiple grounds, including the following:

- 4 (1) Salt has stated a claim for trade dress infringement. The Court spoke
5 and Salt listened. Guided by the directives provided by this Court in
6 its November 19, 2010 Order (the "Order"), Salt made extensive
7 refinements to the Second Amended Complaint ("SAC"). Salt
8 incorporated language taken directly from the operative complaint in
9 *Blue Nile, Inc. v. Ice.Com, Inc.*, the leading published decision in the
10 Ninth Circuit on website trade dress, directly into the SAC. Finally,
11 Salt has removed all "disclaimer" language from its trade dress
12 description in the SAC and provided a detailed synthesis of its trade
13 dress elements. It is now absolutely clear where Salt's trade dress
14 lies.
- 15 (2) Notwithstanding these extensive refinements, Defendants continue to
16 improperly dissect Salt's trade dress into its constituent elements in
17 their present Motion. They then invite the Court to analyze each
18 element in isolation to support the conclusions that each element is
19 functional and has not acquired secondary meaning. The law is clear,
20 however, trade dress elements are to be analyzed in combination, not
21 in isolation.
- 22 (3) In addition to refining its trade dress, Salt also extensively refined its
23 copyright allegations. Among other refinements, Salt's copyright
24 infringement claim is now focused upon one (1) copyright
25 registration, the registration covering the Sale Website.
- 26 (4) Salt's trade dress claims are not preempted by the Copyright Act.
27 Salt's website and catalogs contain material protected under *both* the
Lanham Act and the Copyright Act. As courts in this circuit have

1 recently confirmed, the “look and feel” of a website, while not
2 protectable under the Copyright Act, may be protectable as trade
3 dress.

4 (5) Salt has a valid copyright in its website, which has been registered
5 with the U.S. Copyright Office. Salt’s copyright extends to the “text,
6 photographs, selection, arrangement and compilation” of its website.
7 Defendants summarily claim, however, without any support
8 whatsoever, that the U.S. Copyright Office simply “got it wrong”
9 when it issued Salt’s website copyright registration covering all of
10 those elements. Defendants maintain that websites simply are not
11 copyrightable. Defendants are wrong.

12 (6) Salt’s common law unfair competition and misappropriation claims
13 are also not preempted by the Copyright Act. Each contains the
14 additional elements of deception and misrepresentation and, thus,
15 they are qualitatively different than Salt’s copyright infringement
16 claims.

17 (7) Assuming *arguendo* that the Court concludes that a claim for trade
18 dress infringement has not been adequately stated, and assuming
19 *arguendo* that the Court will not grant leave to amend, then Salt’s
20 copyright infringement claim should be permitted to proceed
21 forward. The present Motion should be denied on those grounds.
22 Similarly, if the Court concludes *arguendo* that the trade dress and
23 unfair competition claims are preempted, then the present Motion
24 should be denied such that Salt can proceed with its copyright
25 infringement claim. Stated differently, there is no basis to dismiss the
26 case in its entirety. Salt has stated at least one viable claim.
27

1 This Opposition shall be based on the accompanying Memorandum of
2 Points and Authorities, the Declaration of Roger N. Behle, Jr., the Request for
3 Judicial Notice, the pleadings, files, and records in this action and any such oral or
4 documentary evidence that might be presented at the hearing on this matter.

5
6 DATED: January 10, 2011 **FOLEY BEZEK BEHLE & CURTIS, LLP**

7
8 By: Roger N. Behle, Jr.
9 Roger N. Behle, Jr., Esq.
10 Attorneys for Plaintiff
11 Salt Optics, Inc.
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MEMORANDUM OF POINTS AND AUTHORITIES

1. Introduction

The present motion to dismiss (the “Motion”) presents a singular question for resolution by the Court: Are websites protectable? Although styled as a challenge to the pleadings, the Motion is really an attack on the application of intellectual property law to websites. Defendants quite decidedly believe that websites are not protectable under trade dress, copyright, or any other intellectual property law.¹ However, they cite to authority to support this sweeping proposition and, instead, conveniently ignore published decisions from this circuit where the courts have acknowledged the viability of intellectual property protection for websites.²

The tacit premise underlying Defendants’ Motion is that websites are in the public domain, freely available to be copied and used by anyone without the consent of the website owner. This comes as no surprise, as this is precisely what Defendants did here. They copied and used sections of the Salt Website without consent. Caught with their hands in the cookie jar, Defendants now know they will lose this case if the Salt Website is found to be protectable. So, they attack the pleadings claiming that Salt has not sufficiently described its trade dress or copyrights. But, in truth, no amount of description or clarification will ever suffice for Defendants; to them, websites are inherently unprotectable.

Indeed, rather than answering the allegations made by Salt, Defendants have repeatedly dodged them by feigning confusion. Their stated excuse was and continues to be that they simply do not understand the nature and scope of the claims being brought by Salt. Without further clarification, Defendants have said they cannot respond; they need “sufficient notice” of the claims. Hearing this, and

¹ See, e.g., Motion, fn. 25 (“Conceptually, it is virtually impossible to establish secondary meaning in a website design. . . . For this reason alone, it appears that there are no reported cases wherein a plaintiff has definitely established trade dress in a website”) and Motion, p. 22, l. 28 (“a ‘website’ *itself* is *not* protected by copyright”) (emphasis original).

² *Blue Nile, Inc. v. Ice.Com, Inc.*, 478 F. Supp. 2d 1240, (W.D. Wash. 2007).

1 recognizing that further clarification of the claims may help to advance the case
2 forward, this Court prudently issued an Order³ granting Salt leave to amend.

3 In the Order, the Court provided guidance as to how the claims should be
4 refined to provide further clarity. Salt carefully read, considered and incorporated
5 the comments made by the Court in order to fashion an improved amended
6 complaint. But Salt went further. It obtained a copy of the operative complaint in
7 *Blue Nile, Inc. v. Ice.com, Inc.*,⁴ the leading case involving website trade dress in
8 the Ninth Circuit, and a case cited by the Court in the Order.⁵ Indeed, *Blue Nile* is
9 the only known published decision in the Ninth Circuit establishing pleading
10 guidelines for website-based trade dress and copyright infringement claims. As this
11 Court acknowledged, intellectual property claims involving the overall appearance
12 of a website present novel issues.⁶ Given the paucity of authority explicating the
13 precise boundaries of website-based claims, *Blue Nile* is authoritative.⁷ Thus, in
14 drafting the Second Amended Complaint (“SAC”), Salt not only incorporated the
15 changes suggested by this Court in the Order, it copied word-for-word the key
16 trade dress allegations from the *Blue Nile* complaint.⁸ The claims in the SAC are
17 now finite and fixed. Defendants have a crystal clear target to shoot at in preparing
18 their defense.

19 In sum, Salt is not clinging to a lifeboat of ambiguity, as Defendants
20 flippantly suggest. Its refined claims are specific and firmly based upon the
21 guidance provided in the Court’s Order, as well as language from motion-tested
22 pleadings in published Ninth Circuit case law. As should now be clear,
23 Defendants’ game plan is to endlessly claim they do not know what they are being

24 ³ See, e.g., Order of November 19, 2010 (the “Order”), p. 7.

25 ⁴ *Blue Nile, Inc. v. Ice.Com, Inc.*, 478 F. Supp. 2d 1240, (W.D. Wash. 2007).

26 ⁵ Order, p. 6.

27 ⁶ *Id.*

⁷ Tellingly, Defendants completely ignore the *Blue Nile* case in the present Motion (and in their preceding motions).

⁸ See p. 2, ll. 3-17, *supra*, and ¶33 of the SAC.

sued for. They will always be able to fashion yet another rhetorical question or claim that an inconsistency exists in the pleadings. On receipt of the SAC, Defendants should have filed an answer. Salt respectfully requests that this Court deny the present Motion and order Defendants to answer.

2. Argument

A. Defendants Have Failed to Meet Their Burden Under Rule 12(B)(6); The Motion Should Be Denied

The Court's familiarity with the standard for measuring motions to dismiss is assumed; but one aspect of that standard bears reinforcement here: "Courts must accept as true all factual allegations in the complaint and must draw all reasonable inferences from those allegations, construing the complaint in the light most favorable to the plaintiff."⁹ Further, motions to dismiss are still granted only in "extraordinary circumstances."¹⁰

Because a motion to dismiss is raised during the pleading stage, before fact-finding has been conducted through discovery, the granting of such motions is looked upon with disfavor by the courts as a drastic remedy.¹¹ Indeed, the threshold for surviving a motion to dismiss is extremely low.¹² When considering a motion to dismiss under Rule 12(b)(6), dismissal is appropriate only when the complaint does not give the defendant fair notice of a legally cognizable claim and the grounds on which it rests.¹³

B. Salt Has Not Only Met, But Exceeded, the Pleading Requirements for its Trade Dress Infringement Claim.

In its Order, the Court expressed concern (1) that the FAC did not contain an adequate synthesis of elements describing the protectable "look and feel" of the

⁹ *Cal. Pharm Mgt., LLC v. Zenith Ins. Co.*, 2009 U.S. Dist. LEXIS 112753 (C.D. Cal. Nov. 5, 2009).

¹⁰ *Germain v. J.C. Penney Co.*, 2009 U.S. Dist. LEXIS 60936 (C.D. Cal. July 6, 2009).

¹¹ *United States v. CBS, Inc.*, 459 F. Supp. 832, 834 (C.D. Cal. 1978) ("pretrial dismissals are highly disfavored, and will only be handed down with extreme prudence and caution").

¹² *Haddock v. Board of Dental Examiners of California*, 777 F. 2d 462 (9th Cir. 1985) (dismissal of complaint improper if its states a claim under any theory).

¹³ *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 127 S. Ct. 1955 (2007).

1 Salt Website and (2) that the “by way of illustration, not by limitation” language in
 2 the FAC left open the possibility that Salt could incorporate other website elements
 3 into the trade dress claim at a later stage.¹⁴ This two-fold concern appeared to
 4 mirror that expressed by the court in *Sleep Science Partners*¹⁵, wherein the mere
 5 cataloging of a website’s components, along with language suggesting that the
 6 plaintiff intends to “redefine its trade dress at a future stage of the litigation” was
 7 held not to give defendants adequate notice.¹⁶ The Court spoke and Salt listened.

8 1. Salt Has Removed the “Disclaimer” Language from its Trade
 9 Dress Description in the SAC

10 In the SAC, Salt removed all language from its trade dress allegations
 11 suggesting that the listed elements are only some potential of the trade dress
 12 elements.¹⁷ Having removed this language, the trade dress allegations in the SAC
 13 are now finite and fixed. Defendant’s suggestion that the word “includes” is
 14 somehow “deliberately vague” is yet another desperate attempt to create ambiguity
 15 where none exists.¹⁸ To the contrary, the word “includes” actually means
 16 “to contain.”¹⁹ This is precisely what the Court said it wanted and Salt has
 17 complied. Defendants are now grasping at straws.

18 2. Salt Has Clearly and Concisely Synthesized its Trade Dress in
 19 the SAC, as Requested by the Court

20 As this Court accurately noted, “[i]ntellectual property claims surrounding
 21 the overall appearance of a website present relatively novel issues.”²⁰ The Court
 22 went on to note that “the Ninth Circuit has yet to explicate the precise boundaries
 23 of trade dress law applied to the internet.”²¹ There is, however, a developing body

24 ¹⁴ Order, pp. 6-7.

25 ¹⁵ *Sleep Science Partners v. Avery Lieberman*, 2010 U.S. Dist. LEXIS 45385, *7 (May 10, 2010).

26 ¹⁶ Order, p. 7.

27 ¹⁷ FAC, ¶31 was removed from the SAC.

¹⁸ Motion, p. 2, l. 24.

¹⁹ See, <http://dictionary.reference.com/browse/include> (“to contain, as a whole does parts or any element”).

²⁰ Order, p. 6.

²¹ Id.

1 of authority establishing the general parameters for trade dress claims involving the
 2 “look and feel” of a website. The leading published opinion on the subject in the
 3 Ninth Circuit is *Blue Nile, Inc. v. Ice.Com, Inc.*²²

4 Like the Defendants here, the defendants in *Blue Nile* brought a motion to
 5 dismiss under F.R.C.P. 12(b)(6), claiming that plaintiff had not sufficiently
 6 described its trade dress in the complaint: “The Court will search in vain for this
 7 [‘look and feel’] allegation in the complaint.”²³ The *Blue Nile* court, however,
 8 disagreed, finding that “plaintiff’s allegations in paragraph 52 of its amended
 9 complaint relating to the ‘design and presentation of diamond search features’
 10 [were] *sufficient* to support a claim that plaintiff is seeking to protect the ‘look and
 11 feel’ of its website.”²⁴

12 In this novel area of the law, the *Blue Nile* court provided guidance as to the
 13 level of specificity required for a plaintiff to sufficiently plead a trade dress for the
 14 “look and feel” of a website. Citing to *Blue Nile* in its Order, this Court urged Salt
 15 to “refine its trade dress in any amended complaint.”²⁵ Accordingly, Salt took great
 16 care to refine its trade dress description in the SAC to comport with the allegations
 17 approved by the court in *Blue Nile*. The steps taken by Salt to comply with the
 18 Court’s Order were as follows:

19 As noted above, the *Blue Nile* court determined that the allegations in
 20 paragraph 52 of the amended complaint were *sufficient* to support a trade dress
 21 claim based on the “look and feel” of a website.²⁶ Paragraph 52 of that complaint
 22 reads as follows:

23 The similarities between the design and presentation of
 24 diamond search features of the Defendants’ www.diamond.com
 website published in interstate commerce and Blue Nile’s

25 ²² *Blue Nile, Inc. v. Ice.Com, Inc.*, 478 F. Supp. 2d 1240, (W.D. Wash. 2007).

26 ²³ *Id.* at 1244

²⁴ *Id.*

²⁵ Order, p. 6.

²⁶ *Blue Nile, Inc.*, 478 F. Supp. 2d at 1244.

1 distinctive diamond search features associated with its quality,
 2 reliability, reputation and goodwill is likely to cause consumer
 3 confusion or to cause mistake or to deceive as to Diamond.com
 4 affiliation, connection, or association with and/or endorsement
 5 or approval by the same source as the Blue Nile diamond search
 6 page.²⁷

7 Following this guide, Salt added paragraph 33 to the SAC, which
 8 incorporated word-for-word the key trade description language from paragraph 52
 9 of the *Blue Nile* complaint. Thus, with the key language from *Blue Nile* underlined,
 10 paragraph 33 of the SAC reads as follows:

11 The similarities between the (1) use of color, (2) visual and
 12 interface design of its eyewear collections and selection
 13 webpages, and (3) logo placement on the Warby Parker website
 14 which is published in interstate commerce and Salt's distinctive
 15 (1) use of color, (2) visual and interface design of its eyewear
 16 collections and selection webpages, and (3) logo placement
 17 which are associated with Salt quality, reliability, reputation
 18 and goodwill is likely to cause consumer confusion or to cause
 19 mistake or to deceive as to the affiliation, connection, or
 20 association with/and/or endorsement or approval by the same
 21 course as the Salt Website.

22 Thus, the single paragraph found by the court in *Blue Nile* to contain the necessary
 23 “look and feel” language (¶52) has now been incorporated into the SAC, at ¶33.

24 Salt, however, acknowledges that this was only the first step. A synthesis of
 25 elements was also to be included in the SAC. To this end, Salt remained mindful of
 26 the second facet of the Court’s two-fold concern stated at pages 6 and 7 of the
 27 Order (the first facet being the “disclaimer” language and the second facet being
 the “mere cataloging” of a website’s features). Having removed the disclaimer
 language, Salt then took great care to synthesize the combination of trade dress

²⁷ Request for Judicial Notice, First Amended Complaint, *Blue Nile v. Ice.Com, Inc.*, ¶52.

1 elements comprising the “look and feel” of its website.²⁸

2 Paragraph 22 of the SAC makes clear that Salt is claiming trade dress
3 comprising the “look and feel” of its website (“[t]he Salt Website incorporates a
4 trade dress comprising a distinctive ‘look and feel’ of elements. . . .[and] includes
5 the placement of photographs, colors, borders, frames, interactive elements and
6 overall mood, style and impression.”).²⁹ Had Salt stopped there, one could argue
7 that Salt had done nothing more than catalogue the features of its website. But Salt
8 went much further.

9 Having identified these features, Salt then carried out the task of showing
10 how they interrelated with one another, in combination, to create the “look and
11 feel” of the Salt Website. Salt accomplished this through a combination of written
12 explanation and graphic images, inserted directly into ¶23 of the SAC.³⁰ This is the
13 synthesis that the Court had requested, and what distinguishes this case from *Sleep*
14 *Science Partners*³¹ and *Conference Archives v. Sound Images, Inc.*³²

15 Defendants can no longer feign confusion. Paragraph 23 of the SAC states in
16 crystal clear, unequivocal terms that “the ‘look and feel’ of the Salt Website is
17 comprised of three elements in combination. . . .” Those three elements are
18 explained and depicted graphically in Paragraph 23, which spans nearly five (5)
19 pages of the SAC. If the written explanations were not enough to convey the “look
20 and feel” of the Salt Website, then certainly actual pictures of the relevant website
21 pages accomplished this task. A picture is worth a thousand words:

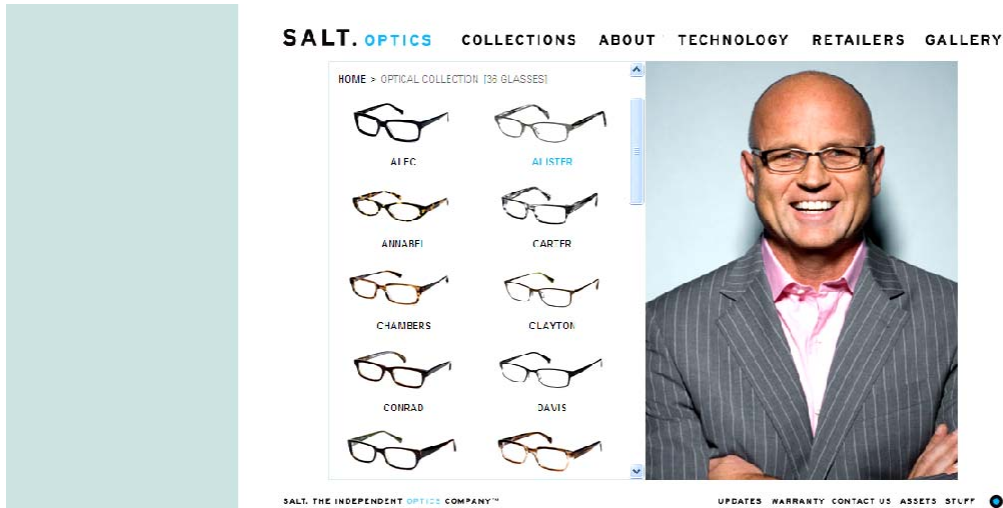
22
23
24 ²⁸ In doing so, Salt made clear that its trade dress was “separate and distinct” from the
copyrightable aspects of its website, SAC ¶10.

25 ²⁹ SAC, ¶22.

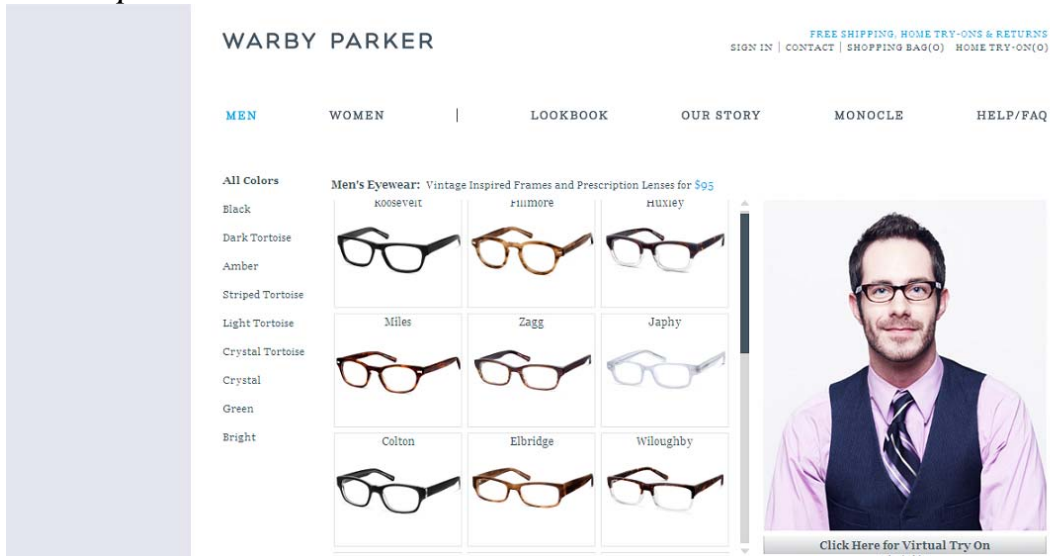
26 ³⁰ To show the level of detailed analysis and synthesis contained in Paragraph 23, Salt originally
intended to reprint that paragraph in its entirety here. However, in that Paragraph 23 spans nearly
five (5) pages, Salt has “discretely” elected to incorporate the same here by reference only.

27 ³¹ *Sleep Science Partners v. Avery Lieberman*, 2010 U.S. Dist. LEXIS 45385, *7 (May 10, 2010).

³² *Conference Archives v. Sound Images, Inc.*, 2010 WL 1626072 (W.D. Pa. 2010).



Salt Optics Website.



Warby Parker Website.

Finally, Defendants suggestion that websites are ever-changing and, therefore, Salt cannot maintain a trade dress claim is easily refuted. The “look and feel” of the Salt Website, as well as its attendant role in identifying Salt as the source of the products featured on the website, can continue in perpetuity even after changes are made. For instance, Defendants falsely imply that Salt’s inclusion of new products on its website destroys trade dress protection.³³ This is nonsense. If one were to accept this premise, then the restaurant chain made famous by the

³³ Motion, p. 13, fn. 26.

U.S. Supreme Court in its *Two Pesos* decision would have lost all trade dress protection (for the décor, paintings, murals and themes of its restaurants) upon making changes to its menu. Trade dress can be maintained in perpetuity, whether they take the form of restaurant décor or the “look and feel” of website, even where “menu” choices have been changed. But, to put to rest any temptation Defendants may have to again complain that they are unsure which “trade dress” they are accused of infringing, Salt is only alleging that Defendants have infringed the trade dress described in the SAC. That is it; Salt is not seeking to enforce “other iterations” of its website.³⁴ Now that this trade dress has been described in abundant detail in the SAC, Defendants have been provided sufficient notice as to the claims they are required to defend.

3. The SAC Not Only Meets, But Exceeds, the Pleading Standards Set Forth in Rule 8 and *Twombly*.

In the present Motion, Defendants continue to argue that Salt’s trade dress infringement claim must fail because it is still not pled with the specificity necessary to satisfy *Twombly*.³⁵ Given the substantial refinements made in the SAC, the level of specificity Defendants still try to extract from Salt at the pleading stage well exceeds what is required under *Twombly*.³⁶ As noted in *Twombly*, “Federal Rule of Civil Procedure 8(a)(2) requires only ‘a short and plain statement of the claim showing that the pleader is entitled to relief,’ in order to ‘give the defendant fair notice of what the . . . claim is and the grounds upon which it rests’.”³⁷ Here, Salt has not only met, but exceeded these requirements. Indeed, as required by Rule 8, the SAC contains an abundance of “written statements” showing Salt is entitled to relief. Salt describes in detail the elements that *in*

³⁴ Motion, p. 11, l. 3.

³⁵ *Id.*

³⁶ *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 127 S. Ct. 1955 (2007).

³⁷ *Bell Atl. Corp.*, 550 U.S. at 555; *citing, Conley v. Gibson*, 355 U.S. 41, 47, 78 S. Ct. 99, 2 L. Ed. 2d 80 (1957).

1 combination comprise its website trade dress.³⁸ Elsewhere in the SAC, Salt
 2 painstakingly describes how these elements interrelate with one another to create
 3 the total visual experience viewers see when entering the website.³⁹ These written
 4 descriptions more than adequately give Defendants “fair notice” of the trade dress
 5 they are alleged to have infringed.

6 Further, from a purely procedural standpoint, it is important to remember that
 7 this case is still at the pleading stage. The parties’ Rule 26 disclosures have not
 8 been exchanged; no written discovery has been conducted; and no depositions have
 9 been taken. And yet, even at this early stage, Defendants demand more than is
 10 required. The rules of pleading do not require this level of detail. By any objective
 11 measure, the SAC provides Defendants with an abundant written description of
 12 Salt’s trade dress such that they have “fair notice” of the claim.

13 In addition, as noted above, Salt has also given Defendants actual “pictures”
 14 of the described website trade dress, by embedding images directly into body of
 15 the SAC⁴⁰ and by attaching a full set of website “screen captures” to the FAC as an
 16 exhibit.⁴¹ Thus, while Rule 8 requires only “short plain *statements*,” Salt has
 17 provided Defendants with actual pictures of its website and the combined elements
 18 comprising its trade dress. These images correspond with the written statements
 19 describing them. In addition to reading about them, Defendants can now *see* the
 20 described trade dress for themselves.⁴²

21 As the foregoing analysis reveals, Defendants reliance upon *Sleep Science*
 22 *Partners v. Avery Lieberman*⁴³ is misplaced. *First*, unlike Salt, the plaintiff in *Sleep*
 23 *Science* did not allege that its trade dress was comprised of elements to be “taken

24 ³⁸ See, e.g., SAC, ¶¶22, 23 and 33.

25 ³⁹ SAC, ¶23.

26 ⁴⁰ Practical limitations precluded Salt from embedding each and every page from its website
 27 directly into the body of the SAC.

⁴¹ SAC, Ex. A.

⁴² See, *Cartier, Inc. v. Four Star Jewelry Creations Inc.*, 2003 U.S. Dist. LEXIS 7844, 13-14
 (S.D.N.Y. May 8, 2003).

⁴³ *Sleep Science Partners v. Avery Lieberman*, 2010 U.S. Dist. LEXIS 45385, *7 (May 10, 2010).

1 in *combination*.”⁴⁴ Only individual “features” of its website were described.⁴⁵
 2 *Second*, the plaintiff did not allege how these elements “interacted” with one
 3 another to create a “particular visual impression.”⁴⁶ Here, Salt went to great lengths
 4 in the SAC (¶23) to describe the interrelation of trade dress elements on its
 5 website. *Third*, and most significantly, the plaintiff in *Sleep Science* did not include
 6 “pictures” of the alleged trade dress in its complaint. In contrast, Salt’s SAC
 7 includes an abundance of visual depictions of its website, which correlate with the
 8 written descriptions of the composite trade dress elements contained in the body of
 9 the SAC. In sum, the plaintiff in *Sleep Science* (intentionally or otherwise)
 10 described its trade dress component-by-component. As a result, that court
 11 expressly limited its analysis to whether the plaintiff had plead sufficient facts “to
 12 support trade dress protection for *each individual component*.” Here, Salt has made
 13 clear that it is the *combination of elements* that constitutes its trade dress.
 14 Defendants have been given more than “fair notice.”

15 4. Salt Has Plead Sufficient Facts to Establish the Distinctiveness
 16 of its Trade Dress

17 Defendants also inaccurately describe what they refer to as the “true test” for
 18 distinctiveness in a website trade dress infringement case.⁴⁷ Defendants assert in
 19 the Motion, without any authority whatsoever, that “Website Trade Dress is not
 20 inherently distinctive. . . .”⁴⁸ Once again, Defendants “jump over” a subtle, yet
 21 critical, distinction in the law of trade dress – namely, that secondary meaning need
 22 not be alleged (or proven) in a trade dress claim involving the “total image and
 23 appearance” of a business, such as the present case. Defendants *presume* the
 24 opposite.

24 ⁴⁴ *Id.* at *8 (emphasis added).

25 ⁴⁵ *Id.* Plaintiff alleged that its website features included “(1) the ability to view SSP’s television
 26 commercial; (2) user testimonials; (3) the screening questionnaire; and (4) the Pure Sleep
 Method.”

26 ⁴⁶ *Id.*

27 ⁴⁷ Motion, p. 10.

⁴⁸ Motion, p. 11, l. 4.

1 In its landmark decision, *Two Pesos v. Taco Cabana*,⁴⁹ the U.S. Supreme
 2 Court held that the trade dress of a business – that is, the total image and
 3 appearance of a business – may be protected under Section 43(a) of the Trademark
 4 Act of 1946 (“Lanham Act”) (15 USC §1125(a)), *without proof that the trade*
 5 *dress has a secondary meaning*.⁵⁰ The trade dress at issue in the *Two Pesos* case
 6 involved the image and appearance of a restaurant business, including the décor,
 7 motifs, “bright colors, paintings and murals” used throughout the restaurants. As to
 8 such trade dress, the Court held that secondary meaning was not required. The
 9 Court noted: “[A]dding a secondary meaning requirement could have
 10 anticompetitive effects, creating particular burdens on the startup of small
 11 companies.”⁵¹

12 Notably, *Two Pesos* (like the instant case) is a “total image and
 13 appearance”⁵² case; it did not involve *product-design* trade dress. Indeed, there is a
 14 critical distinction between product-design trade dress cases and total image and
 15 appearance cases. In the former, secondary meaning is a required element, whereas
 16 in the latter, it is not.

17 That distinction was brought to bear in the U.S. Supreme Court’s decision in
 18 *Walmart Stores v. Samara Bros.*⁵³ In *Walmart*, the Court held that “in an action for
 19 infringement of unregistered trade dress under § 43(a) of the Lanham Act, a
 20 *product’s design* is distinctive, and therefore protectible, only upon a showing of
 21 secondary meaning.”⁵⁴ Reconciling its holding in *Two Pesos*, the Court stated:

22 ⁴⁹ *Two Pesos v. Taco Cabana*, 505 U.S. 763 (U.S. 1992).

23 ⁵⁰ “[P]roof of secondary meaning is not required to prevail on a claim under § 43(a) of the
 24 Lanham Act where the trade dress at issue is inherently distinctive.” *Two Pesos*, 505 U.S. at 776;
 25 Moreover, the Court noted that “[a] particular trade dress. . . is now considered as fully capable as
 26 a particular trademark of serving as a ‘representation or designation’ of source under § 43(a).”
 27 *Id.* at 787.

⁵¹ *Two Pesos*, 505 U.S. at 775.

⁵² *See, Id.* at 764, fn. 1. The U.S. Supreme Court later characterized such trade dress as “*tertium*
 26 *quid*,” to distinguish it from product-design trade dress. *Wal-Mart Stores v. Samara Bros.*, 529
 27 U.S. 205, 215 (U.S. 2000)).

⁵³ *Wal-Mart Stores v. Samara Bros.*, 529 U.S. 205 (U.S. 2000) .

⁵⁴ *Wal-Mart Stores*, 529 U.S. at 216 (emphasis added).

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Two Pesos is inapposite to our holding here because the trade dress at issue, the decor of a restaurant, seems to us *not to constitute product design*. It was either product packaging -- which, as we have discussed, normally is taken by the consumer to indicate origin -- or else some *tertium quid* that is akin to product packaging and has no bearing on the present case.⁵⁵

The same can be said of this case; it is not a product-design trade dress case. Rather, it is the total image and appearance of Salt's business, as expressed on its website, that constitutes protectable trade dress. More specifically, the "look and feel" of the Salt Website are the virtual-world equivalents of the décor, motifs, "bright colors, paintings and murals" found to be protectable trade dress by the United States Supreme Court in *Two Pesos*. In each case, the effect on the consumer is the same – to identify the *source* of the goods or services being offered. The reasoning supporting trade dress protection for brick-and-mortar retail establishments, like restaurants, applies equally to virtual-world retail establishments, like websites. The consumer has the same sensory perceptions, albeit in different media. In the SAC, Salt has pleaded sufficient facts at ¶¶ 11, 13, 14, 15, and 22 to establish distinctiveness.

5. Salt Has Adequately Alleged that its Trade Dress is Non-Functional in the SAC; Defendants Again Urge the Court to Apply The Wrong Test for Evaluating Functionality

Defendants maintain their argument that Salt has not alleged that its trade dress is non-functional. The flaw in this argument, as before, is that it is (1) fact-intensive, not proper for determination on a motion to dismiss and (2) based upon the improper dissection and segregation of Salt's individual trade dress elements, which are each analyzed in isolation, rather than in combination.

To prevail on its trade dress claim, Salt is not required to allege or prove that Defendants "copied" particular elements from its website. Rather, Salt is only

⁵⁵ *Wal-Mart Stores*, 529 U.S. at 215 (emphasis added).

1 required to allege and prove that the “combination of visual elements” taken
 2 together is likely to cause confusion.”⁵⁶ As another court admonished, “we have
 3 repeatedly held that the appropriate test for similarity of trade dress is *overall*
 4 *impression* of the products and the *entirety of the trade dress*. . . .”⁵⁷ Defendants
 5 perpetuate the error by urging the Court to “remove” the functional elements from
 6 Salt’s trade dress.⁵⁸ This is *not* proper.⁵⁹ Rather, the Court should focus on the
 7 “overall impression” created by the trade dress.

8 Compounding the first flaw in Defendants’ argument is their *presumption*
 9 that the only feature from the Salt Website that “could possibly constitute Trade
 10 Dress, is ‘Saltwater Blue’ color.”⁶⁰ This presumption is unsupported by reference
 11 to any authority, case law or statute. Moreover, as set forth above, Salt does not
 12 claim trade dress protection for any single element, but rather the entire “look and
 13 feel” of the Salt Website. But even as to this single element, Defendants suggest
 14 that the Saltwater Blue color is “invisible” on all pages of the Salt Website. This is
 15 clearly not true. Even in the screen capture from the Salt Website, printed above,
 16 the word “**Optics**” is clearly shown in Saltwater Blue. Similarly, the color
 17 Saltwater Blue appears boldly (and without authorization) on the corresponding
 18 screen capture from Defendants’ Warby Parker Website, also printed above, with
 19 the printed the words “**Men,**” “**\$95**” and “**Free Shipping Home Try-Ons &**
 20 **Returns.**”

21 As to Defendants’ attempts to analyze the elements in isolation, courts and
 22 scholarly writers alike have identified the fallacy of this approach, despite its facial
 23 appeal:

The correct test, however, is *not whether the individual*

⁵⁶ See, e.g., *Fuddruckers, Inc.*, 826 F.2d at 842-43 (9th Cir. 1987)).

⁵⁷ *Nora Beverages, Inc. v. Perrier Group*, 269 F. 3d 114, 122 (2nd Cir. 2001) (emphasis added).

⁵⁸ Motion, p. 16, ll. 19-25.

⁵⁹ *McNeil Nutritionals, LLC v. Heartland Sweeteners, LLC*, 511 F. 3d 350, 359-360 (“[I]t is legal error to engage in a ‘detailed analysis of the differences in the marks rather than focusing on the overall impression created by them. . . .’”

⁶⁰ Motion, p. 5.

1 *elements are functional*, but whether the *overall combination of*
 2 *elements, taken as a whole, is functional*. If this were not the
 3 test, then virtually all trade dress would be defined as
 functional.⁶¹

4 Nevertheless, Defendants try to lead the Court down the analytic path of
 5 assessing the functionality of *each* trade dress element in the SAC. Defendants'
 6 argument reduces to a fallacious syllogism: (1) functional elements do not enjoy
 7 protection; (2) Salt's trade dress includes functional elements; (3) therefore Salt's
 8 trade dress does not enjoy protection. What Defendants patently ignore, however,
 9 is that "a particular arbitrary combination of functional features, the combination
 10 of which is not itself functional, properly enjoys protection."⁶² Notably, the Motion
 11 is bereft of *any* analysis of the trade dress elements in combination. This is telling.
 12 As forewarned by the courts, analyzing the functionality of individual elements in
 13 isolation will lead to absurd results – virtually assuring that all trade dress will be
 defined as functional.

14 Defendants also mislead the Court by claiming that all of Salt's trade dress
 15 must appear on the website "homepage" in order to be protectable.⁶³ Again,
 16 Defendants provide no authority for this proposition. To make their point,
 17 however, Defendants improperly attempt to analogize magazine covers to
 18 websites. They claim that a magazine cover is just a like a website homepage. It is
 19 not. While a magazine cover might be the first thing a consumer sees on the
 20 newsstand before making a purchasing decision, websites homepages are not. That
 21 is, websites are not always accessed by the consuming public "through" the
 22 homepage.

23 Most consumers use one of several popular search engines (such as Google[®])

24 ⁶¹ W. Levin, *Trade Dress Protection*, 2nd Ed., vol. 1, §17:1, pp. 17-1 - 17-2 (Thomson
 25 Reuters/West 2009); *citing*, *Sunbeam Products, Inc. v. West Bend Co.*, 123 F. 3d 246, 44 USPQ
 26 2d 1161, 1168 (5th Cir. 1997) ("To the contrary, we have characterized this argument as a
 'fallacious syllogism,' belied by the principle that an arbitrary combination of functional features
 may be non-functional.")

27 ⁶² *Taco Cabana Int'l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1119 (5th Cir. Tex. 1991).

⁶³ Motion, pp. 6-7.

1 or Yahoo®) to find what they are looking for. They type their search terms into the
 2 search engine and the engine provides corresponding results. The results provided,
 3 however, may take the consumer to a page deep within the company website,
 4 rather than to the company homepage. For instance, a consumer looking to buy
 5 boy's clothing at a nationwide retailer (such as Target®) might type the words
 6 "Boys Clothing Target" into a search engine like Google. That actual search, as
 7 conducted on Google, lists the following website page as the top search result:
 8 <http://www.target.com/Boys-Clothing-Kids/b?ie=UTF8&node=13142121>. This
 9 website page, however, is not the Target® homepage. It is a page deep within the
 10 Target® website that features boy's clothing. So, in light of this search result, does
 11 it now follow that any trade dress protection Target® has in its website has been
 12 lost? The obvious answer is no.

13 Similarly weak is Defendants' argument that Salt's "Presentation" and
 14 "Selection Process" of its website are functional. Again, Defendants break down
 15 each feature component in isolation and then argue that such features appear on
 16 other websites. But, Salt has never made such sweeping assertions. Applying this
 17 reasoning, *any* trade dress involving any one of these website features would
 18 necessarily be functional. Defendants have (by design) substituted a superficially
 19 similar yet not equivalent proposition to the one *actually alleged* by Salt, so that it
 20 may be more easily refuted. At no time has Salt ever claimed that it owns the
 21 exclusive right – by trade dress or otherwise – to use a "scroll bar" in isolation.⁶⁴
 22 To be sure, other companies have the right to use "scroll bars" or "model names"
 23 or other individual elements of Salt's trade dress. But, Salt "can protect a
 24 combination of visual elements 'that, taken together, . . . may create a distinctive
 25 visual impression'."⁶⁵ Likewise, Defendant JAND may enter the eyewear market,
 26 but it may not copy Salt's distinctive combination of elements on its website.

27 ⁶⁴ Motion, p. 8.

⁶⁵ *Fuddruckers, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 842-43 (9th Cir. 1987). *quoting*
Falcon Rice Mill v. Community Rice Mill, 725 F.2d 336, 346 (5th Cir. 1984).

1 Defendants' imitation reflects not merely the individual elements of Salt's trade
2 dress, but its distinctive combination of elements.

3 Lastly, the placement of the Salt logo in the upper left portion of the Salt
4 Website is not, *ipso facto*, functional. There are many places a logo can be placed.
5 Take the famous Google[®] website, for instance, where its logo appears in the
6 middle of the webpage (www.google.com). Other companies choose to place their
7 logos in different locations. So, contrary to Defendants' claim, it is not "industry
8 standard" for logos to be placed in the upper left portion of a website.⁶⁶ Because
9 logos can be placed almost anywhere on a website to "function," placement on the
10 upper left of a webpage does not render a logo functional. Beyond this, Salt is not
11 claiming that it owns the exclusive right to place its logo in the upper left portion
12 of its website. Rather, the placement of the logo in this location – taken together
13 with all the other trade dress elements described in the SAC – is what comprises
14 the "look and feel" of the Salt Website.

15 **C. Salt's Trade Dress Claim is Not Preempted by the Copyright Act**

16 Equally unfounded is Defendants' continuing assertion that Salt's trade
17 dress claim is preempted by the Copyright Act. Again using this Court's Order as a
18 guide, Salt has refined its copyright infringement claim to more clearly "identify
19 which portions of the website. . .it accuses Defendants of infringing."⁶⁷ For
20 starters, Salt has limited its copyright infringement claim to a single copyright
21 registration, the registration for the Salt Website.⁶⁸ So, notwithstanding
22 Defendants' attempts to create confusion through semantics,⁶⁹ there is but a single
23 registered copyright at issue in this case. In addition, Salt has refined the "Factual
24 Allegations" section of the SAC to clearly and concisely identify "The Salt

25 ⁶⁶ Motion, p. 9.

26 ⁶⁷ Order, p. 7.

27 ⁶⁸ SAC, ¶16.

⁶⁹ Defendants claim to be confused by the plural use of the word "copyright" in the SAC, even though ¶16 makes it clear that only one copyright registration is at issue in this case. Defendants know this and are once again attempting to create confusion where none exists.

Website Copyright”⁷⁰ so that it can be distinguished from “The Salt Website Trade Dress.”⁷¹

In addition, the Court asked Salt to clarify which portions of the Salt Website it is accusing Defendants of infringing. Therefore, Salt added new paragraphs 44 through 47 to SAC to more clearly and concisely define which portions of the Salt Website were infringed by Defendants. These additional allegations can be summarized, in pertinent part, as follows:

- (a) Salt has a registered copyright in the Salt Website;
- (b) The Salt Website copyright includes compilations of text and photographs;
- (c) The Salt Website includes the arrangement, display of the named glasses on one side of the collection webpage, juxtaposed with a photograph of the glasses being worn by a model on the other at Level One, together with the Level Two webpage, bearing a close up photograph of the glasses featured at a distinct angle above multiple smaller images of the eyewear displaying color choices along with two distinct views of the glasses being worn by a model;
- (d) The Defendants presentation of its compilations of text and photographs, arrangement, display of the named glasses on one side of the collection webpage, juxtaposed with a photograph of the glasses being worn by a model on the other side, which also bears a close up photograph of the glasses featured at a distinct angle above multiple smaller images of the eyewear displaying color choices along with two distinct views of the glasses being worn by a model is substantially similar to original protected elements of Salt Optics copyrighted “Salt Optics 3.6” webpages.

Copyright claims and trade dress claims are often brought in the same action because the subject matter sought to be protected may fall within both of these legal areas. Courts have also found the subject matter of websites to be eligible for protection under both trade dress and copyright laws. Indeed, the very same

⁷⁰ SAC, ¶16.

⁷¹ SAC, ¶¶17-23.

preemption argument made by the Defendants in the present case was considered and rejected in *Blue Nile, Inc. v. Ice.Com, Inc.*⁷² In that case, the plaintiff sought protection for its website under both the Lanham Act and the Copyright Act. Like Defendants in this case, the defendant in *Blue Nile* sought to have plaintiff's trade dress claim dismissed under Rule 12(b)(6), asserting that it overlapped with plaintiff's copyright claims. However, the court refused to dismiss the trade dress claims, finding a lack of authority to support a Rule 12(b)(6) dismissal of a Lanham Act claim based on the availability of an adequate remedy under copyright.⁷³ The nature of the inquiry was fact-intensive and required full development. Of particular significance to the present case, however, was the court's confirmation that the "look and feel" of a website, while not protectable under the Copyright Act,⁷⁴ may be protectable as trade dress.⁷⁵

In the present case, Salt is not attempting to protect the same "text" and "photographs" under duplicative legal theories (trade dress and copyright), as Defendants suggest.⁷⁶ For starters, Salt has focused its copyright infringement claims upon a single registration, the registration covering the Salt Website only. "Clearly, not all "text" is protectable by copyright. For instance, the names of Salt's frame styles – while clearly "text" – fall outside the scope of the Copyright Act.⁷⁷ However, those same names, when combined with other distinctive elements from the website, become an integral part of Salt's overall trade dress. Indeed, even the *types* of names Salt has selected for its frame styles (e.g., first names/surnames) contribute to the "total appearance and image" of its business.

Other text from Salt's Website is protectable under the Copyright Act as a

⁷² *Blue Nile, Inc. v. Ice.Com, Inc.*, 478 F. Supp. 2d 1240, (W.D. Wash. 2007).

⁷³ *Id.* at 1244.

⁷⁴ *Id.* at 1244, fn. 4.

⁷⁵ *Id.* at 1246, fn. 8 ("there are more articles supporting trade dress protection for the 'look and feel' of websites than there are published cases deciding the merits of this theory.")

⁷⁶ Motion, p. 13.

⁷⁷ Right to use of certain words or names is not protected by copyright. *Funkhouser v Lowe's Inc.* (1953, CA8 Mo) 208 F2d 185, 99 USPQ 448.

1 “literary work,” irrespective of whether it is combined with other material.⁷⁸ It is
 2 the *content and context* (i.e., original expression) of this text that qualifies it for
 3 protection under the Copyright Act.⁷⁹ Further, while the particular fonts Salt has
 4 selected for the “text” on its website may not be protectable by copyright,⁸⁰ those
 5 same fonts are valuable constituent elements of Salt’s overall trade dress.⁸¹ The
 6 point is that the very same “text” can be protected under both trade dress and
 7 copyright law. Each protects something different.

8 In the instant case, Salt applied for and received a copyright registration
 9 covering the “*text, photograph(s), selection, arrangement and compilation* of the
 10 Salt Website.”⁸² A copyright registration certificate provides *prima facie* evidence
 11 of the validity of the copyright, such that the holder of the registration certificate
 12 need not put on evidence of the ownership or originality in the copyrighted work.⁸³
 13 The burden is then on the defendant to overcome the presumption of validity.⁸⁴
 14 Defendants have not and cannot overcome this presumption.

15 In a recent case out of the Southern District of California, *Allen v. Ghoulish*
 16 *Gallery*, the court held that the plaintiff was “entitled to copyright protection in the
 17 *selection, arrangement and presentation of the contents of his website.*”⁸⁵

18 ⁷⁸ 17 U.S.C. §102(a)(1).

19 ⁷⁹ “Literary works” are works, other than audiovisual works, expressed in words, numbers, or
 20 other verbal or numerical symbols or indicia. . . . 17 USC § 101.

21 ⁸⁰ However, this appears to be an open question in light of “the House Committee’s statement that
 22 it “has considered, but chosen to *defer*, the possibility of protecting the design of typefaces. . . . 1-
 23 2 Nimmer on Copyright § 2.15; *but see, Eltra Corp. v. Ringer*, 1976 U.S. Dist. LEXIS 12611
 24 (E.D. Va. 1976) (denying copyright protection and registration of typeface designs).

25 ⁸¹ Font style, size, or color of words, letters, or numbers may be claimed as an element of trade
 26 dress or trademark applications (37 C.F.R. §2.52(a)).

27 ⁸² See, Declaration of Roger N. Behle, Jr. (“Behle Decl.”), ¶ 5. Notably, the copyright registration
 for the Salt Website was submitted on a “special handling” basis. Thus, the application was
 reviewed by a staff examiner at the U.S. Copyright Office upon receipt. After discussion with
 counsel for Salt, the staff examiner recommended and approved the description for the Salt
 Website, namely the “text, photographs, selection, arrangement and compilation” of the website.

⁸³ See, 17 U.S.C. §410(c); *Education Testing Serv. v. Simon*, 95 F. Supp. 2d 1081, 1087 (C.D.
 Cal. 1999).

⁸⁴ *Bibbero Systems, Inc. v. Colwell Systems, Inc.*, 893 F. 2d 1104, 1106 (9th Cir. 1990).

⁸⁵ *Allen v. Ghoulish Gallery*, 2007 WL 4207923, *4 (S.D. Cal., Nov. 20, 2007).

1 Similarly, in *Kantemirov v. Goldine*,⁸⁶ decided in the Northern District of
 2 California, the court held: “Given the flexible definition of works falling within the
 3 scope of the Copyright Act, the court concludes that *the website design and layout*
 4 *in question falls within the general subject matter of the Copyright Act.*”

5 The Copyright Act, itself, provides further support for the conclusion that
 6 Salt’s website copyright comprises more than just “text” and “photographs,” as
 7 suggested by the Defendants. In addition to text and photographs, Salt’s copyright
 8 registration also covers the “*selection, arrangement and compilation* of the Salt
 9 Website.”⁸⁷ “Compilations” are among the copyrightable subject matter set forth in
 10 the Copyright Act.⁸⁸ Thus, the scope of Salt’s website copyright is limited to the
 11 selection, arrangement and compilation of the elements contained on the website.

12 This reveals the flaw in Defendant’s next argument, namely, that Salt’s
 13 copyright infringement claim must be dismissed because of alleged “changes” to
 14 Salt’s website.⁸⁹ *First*, there is nothing in the SAC suggesting that there have been
 15 any changes to the copyrightable subject matter on the Salt’s website. Nor have
 16 Defendants presented any such evidence. Recall that Salt’s copyright includes the
 17 selection, arrangement and compilation of various elements on the website. So,
 18 even though a particular element⁹⁰ may change, the arrangement and compilation
 19 structure of all elements relative to one another remains the same. *Second*, even if
 20 there were changes to the copyrightable subject matter, Defendants do not escape
 21 liability because of those changes. Assume, for the sake of illustration, that
 22 Defendants were found to have infringed version “A” of the Salt website for a

23 ⁸⁶ *Kantemirov v. Goldine*, 2005 WL 1593533, *4 (N.D. Cal., June 29, 2005)

24 ⁸⁷ SAC, Ex. B (emphasis added).

25 ⁸⁸ “Section 103(a) of the Copyright Act, in addition to recognizing copyright in derivative works,
 26 also provides that the subject matter of copyright as specified in Section 102 includes
 27 compilations. A compilation is defined as: a work formed by the collection and assembling of
 preexisting materials or of data that are selected, coordinated, or arranged in such a way that the
 resulting work as a whole constitutes an original work of authorship.” 1-3 Nimmer on Copyright
 § 3.02.

⁸⁹ Motion, p. 23.

⁹⁰ This includes elements that, standing alone, would not be independently copyrightable.

1 period of one year. That Salt later changed its website (to version “B”) does not
 2 relieve Defendants of liability for having infringed version “A” for the preceding
 3 year. Here, Defendants have failed to show that they have not infringed the Salt
 4 website or catalogs – in *any* version.

5 “In a statutory infringement action, it is no longer necessary that either a
 6 copy of the work allegedly infringed, or a copy of the allegedly infringing work,
 7 accompany the complaint.”⁹¹ Thus, Defendants’ request that the Court render a
 8 factual finding of “non-substantial similarity” before the Court has had the
 9 opportunity to see all the copyrighted works at issue is in an invitation for error.
 10 Moreover, even a cursory review of the representative samples of Defendants’
 11 website and Salt’s website embedded into the SAC reveals them to be
 12 substantially, if not strikingly, similar.

13 Lastly, Defendants argue that Salt has failed to state claims for vicarious
 14 copyright infringement or contributory copyright infringement.⁹² In considering
 15 this argument, however, one must query whether Defendants have even read the
 16 SAC.

17 **D. Salt Has Stated Claims for Common Law Unfair Competition**
 18 **Claim and Common Law Misappropriation; These Claims are Not**
 19 **Preempted by the Copyright Act.**

20 Lastly, Defendants argue that Salt has failed to state claims for common law
 21 unfair competition and common law misappropriation. As with their other
 22 arguments, however, this argument is similarly based on a false premise, namely,
 23 that Salt’s common law claims are really copyright claims. This premise is based
 24 upon a selective reading of the fifth and seventh causes of action. Notably,
 25 Defendants neglect to point out that the unfair competition cause of action includes
 26 allegations of deception and misrepresentation.⁹³ So too does Salt’s common law

27 ⁹¹ 1-12 Nimmer on Copyright § 12.09.

⁹² Motion, pp. 16, fn 30.

⁹³ SAC ¶¶ 68-73.

misappropriation cause of action.⁹⁴ Copyright infringement claims, in contrast, do not require such allegations. Indeed, crucial to liability under an unfair competition cause of action or misappropriation cause of action is the element of misrepresentation or deception, which is no part of a cause of action for copyright infringement.⁹⁵ Thus, because they are qualitatively different from a copyright infringement claim, Salt's common law unfair competition claim and misappropriation claim are not preempted.

3. Conclusion.

For the foregoing reasons, Salt respectfully requests that this Court DENY Defendants' Motion in its entirety. The most cursory review of Salt's SAC reveals that it more than adequately sets forth claims against Defendants. Should this Court disagree, Salt requests that it be granted a further leave to amend.⁹⁶ However, assuming *arguendo* that the Court concludes that a claim for trade dress infringement has not been adequately stated, and assuming *arguendo* that the Court will not grant leave to amend, then Salt respectfully requests that its copyright infringement claim be permitted to proceed forward. Similarly, if the Court concludes *arguendo* that the trade dress and unfair competition claims are preempted, then the present Motion should be denied such that Salt can proceed with its copyright infringement claim.

DATED: January 10, 2011 **FOLEY BEZEK BEHLE & CURTIS, LLP**

By: Roger N. Behle, Jr.
 Roger N. Behle, Jr., Esq.
 Attorneys for Plaintiff

⁹⁴ SAC ¶75.

⁹⁵ See, e.g., *Computer Mgmt. Assistance Co. v. Robert F. DeCastro, Inc.*, 220 F.3d 396, 404 (5th Cir. 2000); *Rutledge v. High Point Reg'l Health Sys.*, 558 F. Supp. 2d 611, 620 (M.D.N.C. 2008); *Firoozye v. Earthlink Network*, 153 F. Supp. 2d 1115, 1128 (N.D. Cal. 2001); *Titan Sports v. Turner Broadcasting Sys.*, 981 F. Supp. 65, 71 (D. Conn. 1997); *Lee v. Mt. Ivy Press, L.P.*, 63 Mass. App. Ct. 538, 827 N.E.2d 727, 738 (2005); *Samara Bros. v. Wal-Mart Stores*, 165 F.3d 120 (2d Cir. N.Y. 1998), *rev'd on other grounds*, 529 U.S. 205, 120 S. Ct. 1339, 146 L. Ed. 2d 182 (2000).

⁹⁶ *Cook, Perkiss & Liehe, Inc. v. N. Cal. Collection*, 911 F.2d 242, 246-47 (9th Cir. 1990).

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing document was filed electronically on January 10, 2011 in compliance with Civ. L.R. 5.4. As such, this document was served on all filing users. See Civ. L.R. 5.4(c).

Roger N. Behle, Jr.
Roger N. Behle, Jr.

PROOF OF SERVICE**STATE OF CALIFORNIA****COUNTY OF ORANGE**

)
) ss
)

I, the undersigned, declare that I am, and was at the time of service of the papers herein referred to, over the age of 18 years and not a party to the within action or proceeding. My business address is 575 Anton Boulevard, Costa Mesa, California, 92626.

On January 10, 2011, I served the following document(s):

**PLAINTIFF, SALT OPTICS, INC.'S OPPOSITION TO DEFENDANTS' MOTION TO
DISMISS FOR FAILURE TO STATE A CLAIM; MEMORANDUM OF POINTS AND
AUTHORITIES IN SUPPORT THEREOF**

on the following person(s), with the name and address of the person served shown on the envelope as follows:

Harry P. Weitzel
PEPPER HAMILTON LLP
4 Park Plaza, Ste 1200
Irvine, California 92614


M. Kelly Tillery, Esq.1
Christopher D. Olszyk, Jr., Esq.*
PEPPER HAMILTON LLP
3000 Two Logan Square
Eighteenth and Arch Streets
Philadelphia, PA 19103-2799

☐ BY FACSIMILE: I caused the above-referenced document(s) to be served on the person(s) listed above by facsimile and from Foley & Bezek, LLP's facsimile machine no. (805) 962-0722.

☐ BY E-MAIL: I submitted an electronic version of the above-referenced document(s) to the person(s) whose e-mail address(es) is/are known to me as listed above.

x BY MAIL: I am familiar with the practice at my place of business for collection and processing of correspondence for mailing with the United States Postal Service. The above-referenced document(s) will placed in an envelope, addressed to the person(s) listed above, sealed, and deposited with the United States Postal Service with postage fully prepaid in accordance with the ordinary course of business.

I declare under penalty of perjury under the laws of the State of California and the United States of America that the foregoing is true and correct. Executed on January 10, 2011, at Costa Mesa, California.


Jenna Loeser